

REMARKS

35 USC §103(A)

Claims 1-26 and 57 are rejected under 35 USC 103(a) as being unpatentable over Cobb et al. (US 3608297) in view of Miller et al. (US 2003/0165656). The Applicant respectfully disagrees.

Claim 1 recites:

“A fiber material, comprising:

a first base fiber component comprising a first denier and a first luster component;

a second base fiber component comprising a second denier and a second luster component, wherein the first denier and the second denier are different and wherein the first luster component and the second luster component are different; and

a plurality of binder fibers.”

As recited in the claim, there are three components in the fiber material - two base fiber components – each having a denier and a luster component, whereby the individual deniers and luster components are different, and a plurality of binder fibers.

The Miller publication teaches a conventional carpet fiber and a binder material, wherein the yarn is subject to singeing to remove protruding fiber ends, and subjected to heat sufficient to melt the binder fiber. The Miller publication – as the Examiner admits – is silent as to the use of mixed denier and different luster components.

The Cobb reference, on the other hand, teaches a yarn with a combination of delustred filaments, wherein the yarn is designed to provide an improvement in appearance by giving anti-

soiling effects. In the Examples Section of the Cobb reference, Cobb points out that when comparing a carpet contemplated by Cobb with an conventional carpet, “the difference in soiling by visual observation was apparent after 30 days”. As a matter of fact, the Examples are focused entirely on pointing out that the yarns and carpets described by Cobb resist soiling over conventional yarns and carpets.

The Federal Circuit has stated that “[o]bviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination.” (See *In re Geiger*, 815 F.2d 686, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987)). The Patent Office applies the same standard. “When the incentive to combine the teachings of the references is not readily apparent, it is the duty of the examiner to explain why combination of the reference teachings is proper...Absent such reasons or incentives, the teachings of the references are not combinable.” (See *Ex parte Skinner*, 2 USPQ2d 1788, 1790 (BPAI 1986)). The Federal Circuit crystallizes this concept by the following ruling:

“It is impermissible to use the claimed invention as an instruction manual or “template” to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that “[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.” (See *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992) (quoting *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988)).

Close adherence to this standard is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one “to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against the teacher.” (See *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999)(citing *W. L. Gore & Assocs. v. Garlock, inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984)). In addition, a general relationship

between fields of the prior art patents to be combined is insufficient to establish the suggestion or motivation. (See *Interactive Techs., Inc. v. Pittway Corp.*, Civ. App. No.: 98-1464, slip op. at 13 (Fed. Cir. June 1, 1999)(unpublished), cert. denied, 528 U.S. 1046 (1999). As stated by the Federal Circuit:

“The genius of invention is often a combination of known elements which in hindsight seems preordained. To prevent hindsight invalidation of patent claims, the law requires some “teaching, suggestion or reason” to combine cited references... When the art in question is relatively simple, as is the case here, the opportunity to judge by hindsight is particularly tempting. Consequently, the tests of whether to combine references need to be applied rigorously.” (*McGinley v. Franklin Sports Inc.*, 262 F.3d 1339, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001)(citing *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997)).

Failure of the Examiner to provide the necessary suggestion or motivation will create a presumption that the combination of references selected by the Examiner to support the obviousness rejection was based on hindsight. (Irah H. Donner, *Patent Prosecution, Practice & Procedure Before the U.S. Patent Office*, Third Edition) In this case, the Examiner fails to point out how one of ordinary skill in the art would read Cobb and determine that the yarns or carpet fibers need to be improved, especially given the fact that the crux of the invention in Cobb is improving yarn's and carpet's anti-soiling effects. The Examiner states in the Final Office Action that Miller overcomes the disadvantages of using either staple fibers or continuous filaments in the production of carpets by using binder fibers; however, the Examiner doesn't explain why someone reading Cobb would think to include binder fibers, given that Cobb solves the problem of aesthetics and soil-ability with other means. It is improper to say that Cobb would include binder fibers had Cobb known about them through the Miller reference, because Cobb doesn't state that there are additional needs that should be met by something like a binder fiber. The Examiner is using the template approach to combine

these references based on hindsight. There needs to be some motivation in the references to combine those references, not a puzzle that is assembled by the Examiner because of some perceived need in the references.

The Examiner then states that the motivation to combine comes from Miller and not Cobb, but again, this doesn't help the Examiner's case for the combination. The Miller publication teaches a conventional carpet fiber and a binder material, wherein the yarn is subject to singeing to remove protruding fiber ends, and subjected to heat sufficient to melt the binder fiber. The Miller publication – as the Examiner admits – is silent as to the use of mixed denier and different luster components. The Examiner has not adequately explained why one of ordinary skill in the art would read Miller and even think to combine it with Cobb to get mixed denier and different luster components at the same time. There is just no motivation.

Based on this argument, claim 1 is allowable as being patentable over the Cobb reference in view of the Miller publication. In addition, claims 2-26 and 57 are also allowable as being patentable over the the Cobb reference in view of the Miller publication by virtue of their dependency on claim 1.

REQUEST FOR ALLOWANCE

Claims 1-26 and 57 are pending in this application, and the Applicant respectfully requests that the Examiner reconsider all of the claims in light of the arguments presented and allow all current and pending claims. The Applicant also respectfully requests that the Examiner contact the Applicant if a Notice of Allowance will not be issued, so that the Applicant can timely file a Notice of Appeal.

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By:

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